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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/324,601	06/02/1999	STEVEN C. ROBERTSON		1766

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STEVEN ROBERTSON
26903 138TH AVENUE SE
KENT, WA 98042

EXAMINER

FADOK, MARK A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 01/16/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/324,601

Applicant(s)

ROBERTSON, STEVEN C.

Examiner

Mark A Fadok

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/21/2002 has been entered.

Response to Amendment

The Examiner is in receipt of Applicant's amendment in response to Office action dated 5/14/2002. Acknowledgement is made that Applicant has canceled claims 2,19-22 and amended claims 1,3,4, and 8, leaving claims 1,3-18 as pending. The arguments as presented are considered moot in view of the new rejection necessitated in part by amendment.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 3,4,6,11-18 are rejected as follows;

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The

Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 3,4,6,11-18 recite the broad recitation in the claim to which they are dependant, and the claim also recites the features which follow may and can in each of the respective claims, which is the narrower statement of the range/limitation.

Claim 10 is rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim is narrative in form and replete with indefinite and functional or operational language. The structure, which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

Regarding claims 3-8,10 and 17, it has been held that the functional "whereby" statement does not define any structure and accordingly cannot serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

Claim 1 recites the limitation "restriction" in the last sentence. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

Claim 1 recites the limitation "customization data" in one of the limitations. There is insufficient antecedent basis for this limitation in the claim.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claim states that the Manufacturer information contains the relationships of which resellers sell the manufacturers products. Although the specification mentions that there is a manufacturers database the specification does not described what is contained in the manufacturers database or what particular use the gathering of this data accomplishes.

Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make

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and/or use the invention. In this case the acronym "PIN" needs to be defined. For the purpose of this action, "PIN" will be defined as a Personal Identification Code.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7,9,10, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over WebCertificate.com (a collection of articles from the accompanying PTO 892 and listed as Webcertificate.com1 and 2) further in view of Official notice.

In regards to claim 1, Webcertificate.com discloses a system for providing an electronic gift certificate service over a distributed network, with the capability to support

multiple online merchants of any size and from any net-accessible location in the world, the system comprising:

a plurality of Merchant sites connected to the distributed network (Webcertificate.com2, page 8), each Merchant site running at least one service application to provide an online service to users over the distributed network (Webcertificate.com2, page 12, line25-35); a plurality of Manufacturer sites connected to the distributed network, each Manufacturer site running at least one service application to provide an online service to users over the distributed network. As shown above Webcertificate.com2 provides a method for a seller to accept the gift certificate provided they have the capability to process major credit cards (e.g. the service application).

WebCertificates.com does not limit the use of the certificate to only merchants and it is old and well known in the art that manufactures as well as merchants may have a web presences along with credit card processing capabilities, therefore, it is understood that Webcertificate.com can include merchants as well as manufacturers or any other entity provided the entity has major credit card processing capability e.g. a service application; a plurality of user computers connected to the distributed network, each user computer running at least one client application for accessing online service of the Merchant sites (Webcertificate.com2, page 10 last 7 lines);

a Gift Certificate Authority site connected to the plurality of Merchant and Manufacturer sites (Webcertificate.com2, page 11, last 2 paragraphs), the gift certificate site including a user database, a manufacturer database, and a merchant database containing authentication information of registrants. Webcertificate.com teaches a database for

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managing a gift account including authentication information of registrants (Webcertificate.com page 12, para 6, and page 11 last paragraph), but does not specifically mention that the information is held in multiple databases. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the information in any number of relational databases, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70,

the registered users accessing the Merchant sites from the user computers over the distributed network (page 11, last paragraph). ;

a database which stores user-specific customization data, the customization data specifying preferences of the registered users with respect to the online services of the Merchant sites. The use of profiles to specify preferences is old and well known in the art and could have been used by Webcertificates.com, because this would provide the website a method of directing the user to a preferred merchant website quickly; and a database which stores contribution information related to registrants and beneficiary information (Webcertificates.com page 14 and Page 10, para, 3), the contribution information which allows one-time or reoccurring contributions to specified beneficiaries Webcertificate.com2, page 10, paragraph 3.2 states "indicate when you would like the Webcertificate to be sent (immediately or at a later date)", therefore, it is inherent in the system of Webcertificate that multiple orders can be made at varying times reoccurring on dates specified by the purchaser;

and a database, which stores the gift certificates and related transactions

(Webcertificate.com, page 11 last paragraph);

a database which stores Manufacturer information, the Manufacturer information contains the relationships of which resellers sell the manufacturers products Databases containing information regarding manufactures and there relationship with resellers is old and well known in the art and could have been used by Webcertificate.com, because this would provide detailed information about the manufactures products which the reseller might not have available, increased information providing; and an authentication protocol for allowing the gift certificate site to authenticate users, manufacturers, and merchants and communication links with the partner systems, the authentication protocol implemented by software components of the Manufacturer, Merchant, and Gift Certificate sites. and a database which stores Merchant information, the Merchant information specifying communication information necessary for establishing secure connections between the Merchant and the Gift Certificate system; a purchase validation protocol between the electronic gift certificate service and the Merchant for authorizing the purchase based on the restrictions applied by the purchaser. As stated by the Applicant on page 16 of the specification "Upon the user choosing to use a gift certificate as payment, the Merchant Server Application 62 establishes a secure communication link with the Gift Certificate site 80. This involves the transmission of a "negotiate" message from the Merchant Server Application 62 to the Gift Certificate Registrar 82. This negotiate message includes the Merchant's unique ID, which may be in the form of a digital certificate. The

Gift Certificate Registrar 82 on the Gift Registry Site 80 responds to the negotiate message by sending a pseudo-random "challenge" message to the Merchant's Gift Certificate Agent 64. In response to the challenge message, the Gift Certificate Agent 64 software generates and returns a cryptographic "response" message, which is based on both the challenge message and the SP's password. The above-described method of requesting authentication is commonly referred to as a "challenge-response authentication" protocol and is widely understood in the industry. It is shown in FIG. 10 with the numbered arrows 1-4 indicating the order in which these messages are passed. For more detailed information, see Rivest, R., "The MD4 Message Digest Algorithm," Proceedings, Cryptop '90, Springer-Verlag, Aug. 1990. For a description of other cryptographic algorithms, which may be used, see Stallings, W., Network and Internetwork Security, Prentice Hall, 1995.)". As the Applicant has stated authentication protocol methods are old and well known in the art and could have been used by Webcertificates, because the central location would need to assure the identity of the user so that fraud is limited and security is maintained.

In regards to claim 3, Webcertificate.com teaches the purchaser may place restrictions on the use of the gift certificate. Webcertificates.com teaches placing limits on the gift certificate such as amount of purchase and who may use the gift certificate.

In regards to claim 4, Webcertificate.com teaches the purchaser may track the use of the gift certificate down to the individual product or products purchased.

Webcertificate.com² provides a database for storing and tracking account balances

(page 11, last paragraph), but does not specifically mention tracking the use of the gift certificates down to individual product or products purchased. As stated by applicant on page 11 para. 6 of the specification, "Sales Transaction information may contain but is not limited to the associated merchant that the purchase was made from, product information including manufacturer ID, UPC Code, Merchant Code, Merchant Product Code, Product description, Quantity, Unit Prices, and Order totals including shipping and handling and taxes. All typical information that is associated with an online order is provided and stored with the transaction. This information is common knowledge in the industry". It would have been obvious to a person of ordinary skill in the art to include in Webcertificate.com the tracking capabilities that are old and well known in the art as stated by applicant, because this information can be used by the purchaser to supervise the activity of the gift recipient. This supervision capability would provide additional revenue from persons in need of this type of supervision.

In regards to claim 5, Webcertificate.com teaches a search mechanism provides for accessing the sales transactions associated with a gift certificate (webcertificate.com2, page 11, last paragraph).

In regards to claim 6, Webcertificate.com teaches an individual or company may contribute to beneficiaries electronically (See page 14 and Page 10, para, 3).

In regards to claim 7, Webcertificate.com teaches contributions can be made automatically on a re-occurring basis. Webcertificate.com2, page 10, paragraph 3.2 states "indicate when you would like the Webcertificate.com to be sent (immediately or

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at a later date), therefore, it is inherent in the system of Webcertificate.com that multiple orders can be made at varying times reoccurring on dates specified by the purchaser.

In regards to claim 9, Webcertificate.com teaches an electronic gift certificate to be split across multiple purchases at a plurality of merchants (webcertificate.com2, page 2).

In regards to claim 10, Webcertificate.com discloses a method whereby gift certificate purchasers may place restrictions on the use of that certificate, comprising the steps of:

Indicating interest to purchase electronic gift certificate;

Entering the desired dollar amount to be applied to the gift certificate;

Entering a PIN # for authentication in the redemption process;

Optionally, entering any restrictions on use;

Providing payment information to Gift Certificate site;

Gift Certificate site validating payment information;

Confirming the order;

Receiving an Order Confirmation, the order confirmation being shown via online display immediately and later e-mail notification;

Whereby a gift certificate purchaser can make a purchase in a timely manner from the convenience of their home or office and the purchaser's privacy is maintained (see discussion in claims 1-7 and 9 above and Webcertificate.com 1 and 2 in their entirety).

17. A method whereby the registrant may contribute electronically to beneficiaries on a reoccurring basis (see response to claim 7).

Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webcertificate.com, and further in view of Walker et al. (5,884,270).

In regards to claim 8, Webcertificate.com teaches contributions can be made anonymously at the time of purchase. Webcertificates.com teaches providing contributions at the time of purchase, but does not specifically mention maintaining the anonymity of the gift giver. Walker et al. teaches a communication system incorporating a central database of information supplied by one or more parties and

managed by a central administrator, where all parties to the system can manage and control the release of any or all information about themselves or

their identities, and where such a system allows for electronic-based communications between the parties without the necessity of revealing the

identity of either party (col 4, lines 18-25) and specifically mentions the system can be use for making anonymous charitable gifts (col 1, line 64 to col 2, line 5). It would be obvious to a person of ordinary skill in the art to include in Webcertificate.com the teachings of anonymity provided by Walker, because providing this capability would allow a person that does not wish to have there identity known to use the system thus increasing revenue for the website.

In regards to claim 18, Webcertificate.com teaches a contribution can be made anonymously (see response to claim 8).

Claims 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webcertificate.com, and further in view of Foladare (5,914,472).

In regards to claims 11-17, Webcertificates.com teaches placing limits on the gift certificate such as age of user and amount of purchase. Webcertificate.com also teaches a database for monitoring the transactions of the gift recipient, but does not specifically mention all the individual restrictions listed in claims 11-16. Foladare teaches a database of limits for monitoring and limiting a transaction card used by a minor (abstract and FIG 2). Foladare does not list all the specific limits cited in the claims but does not limit the number or types of limitation that can be placed in the "limits" database (item 208), therefore, Foladare could include any number of restrictions including the ones listed in claims 11-16 if so desired. It would be obvious to a person of ordinary skill in the art to include these additional restrictions because additional restrictions would provide an automatic method of monitoring the use of a gift certificate.

Response to Arguments

Applicant's arguments with respect to claims 1,3-18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Friday 8:00 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(703) 308-1344**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

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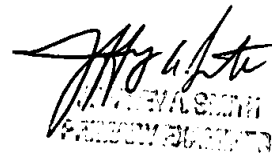
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

Mark Fadok
Patent Examiner



WYNN COGGINS
SUPERVISOR